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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,305	02/06/2004	John H. Moorhouse	2237.08US03	5435
24113	7590	08/10/2005	EXAMINER	
PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100			TRAIL, ALLYSON NEEL	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/774,305	<b>Applicant(s)</b> MOORHOUSE ET AL.	
	<b>Examiner</b> Allyson N. Trail	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-05, 6-04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Continuing Data*

1. This application is a CIP of 10/268,065, patent 6,764,007, filed October 9, 2002, which is a continuation of 10.057,598, patent 6,449,660, filed January 24, 2002.

### *Claim Objections*

2. Claims 1 and 35 are objected to because of the following informalities:

Re claims 1 and 35, line 5: replace "the surface" with --surface--.

Appropriate correction is required.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5, 9, 17-19, 21, 27, 35-39, and 43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-7, 10-12, and 22 of U.S. Patent No. 6,764,007, hereinafter '007.

Additionally, claims 1-5, 9, 35, 36, 38, and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4,

9, and 14 of U.S. Patent No. 6,499,660, hereinafter '660.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Both the current application and patents '007 and '660 claim the same subject matter including a security lock comprising at least one key insertable into the lock; a plurality of rotatable discs with at least one of the discs being rotatable by the at least one key; a plurality of sensors capable of sensing the surface changes of the rotatable discs; a controller in operable communication with the plurality of sensors, the controller adapted to process data from the sensors; and an input device in operable communication with the controller to input transactional data for processing by the controller.

With regards to the double patenting rejection with '007, claims 3 and 37 of the current application include limitations of claims 4 and 5 respectively from '007. The limitations of claims 1, 4, 35, 36, and 38 of the current application are included in claim 1 of '007. Claims 5 and 39 of the current application include limitations of claim 6 from '007. The limitations of claims 9 and 21 of the current application are included in claim 12 from '007. Lastly, claims 2, 17, 18, 19, 27, and 43 of the current application include limitations of claims 4, 2, 7, 10, 11, and 22 respectively from '007.

With regards to the double patenting rejection with '660, claims 1, 4, 35, 36, and 38 of the current application include limitations of claim 1 from '660. Claims 5 and 39 of the current application include limitations of claim 9 from '660. Lastly, claims 2 and 9 of the current application include limitations of claims 4 and 14 respectively from '660.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.32(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.78(d).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 4, 9, 10, 15-17, 35, 37, 38, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Gokcebay et al (6,552,650).

Gokcebay et al teaches the following in regards to claims 1, 3, 4, 15-17, 35, 37, and 38:

“A mechanical lock and key includes an electronic access control feature for preventing opening of the lock unless prescribed conditions are met.” (Abstract).

“The mechanical key has a key head with a battery, microprocessor and database. When the key is inserted into the lock, a one-wire bus connection sends the

lock ID to the key's microprocessor, a comparison is made by the microprocessor to determine whether the lock is authorized to be opened, and if so; a code for the addressable switch, determined from the key database, is sent via the one wire bus to the switch, powering the solenoid, withdrawing the blocking pin and enabling opening of the lock. (Abstract).

Figure 7 shows a mechanical key 52. The key 52 has an enlarged key head 58, sufficient to contain internal electronic components and to also have an external input device (keypad 60) and, preferably, a small display 62.

As explained in column 1, lines 44-58; a lock includes a plurality of tumbler discs and at least one of the discs are rotated by a key. It is sensed when one of the discs are rotated. A controller, which controls the lock, recognizes the detected rotation of the disc and the lock is then unlocked. The discs consist of highs and lows along the surfaces.

Gokcebay et al teaches the following in regards to claims 9 and 10:

"Another feature of the invention is a small keypad on the head of the key. This can be used for additional security, to require an operator to input an authenticating code known only to the proper operator. Thus, the key cannot be used by an unauthorized person. The programming of the microprocessor preferably is set so that the operator enters his PIN number at the start of a route wherein a series of locks will be opened." (Col. 4, lines 42-49).

Gokcebay et al teaches the following in regards to claim 43:

Figure 7 illustrates a small display 62.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 5, 6, 11, 12, 18, 21-23, 25-31, 33, 34, 36, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gokcebay et al (6,552,650) in view of Chaum (6,318,137).

Gokcebay et al's teachings are discussed above (including the input device being housed with a remote processing system separate from the lock as disclosed in claims 25 and 26, entering a PIN as disclosed in claim 31 and having the processing system housing remote from the lock and a display as disclosed in claims 33 and 34).

Gokcebay et al however fails to teach the sensors being capable of sensing the reflective surface changes or being an infrared sensor and additionally fails to teach comparing data from the sensors, which are used to generate a lock command signal.

Chaum teaches the following in regards to claims 2, 12, 18, 21, 22, 27-30, 36, 39, and 40:

"Various sensor technologies can be used for each approach, such as by use of a digital camera, array of light/infra-red sources and/or sensors, the reflection patterns of other energy directed at the key, other metal detection sensor techniques, or any other sensor technology that may already be or become known in the art." (Col. 9, lines 45-51).

Chaum teaches the following in regards to claims 5, 6, 11, and 23:

Claim 1, which includes an electronic lock system comprising, "a sensor configured to sense at least a portion of the biting profile shapes of flat rigid cylinder-lock type keys inserted into said keyway channel of the electronic locking system; a comparator coupled to the memory and the sensor, the comparator configured to compare a sensed biting profile shape with the stored shape related information stored in said memory; and an actuator configured to unlock the electronic locking system at least partially in response to the comparator determining that the sensed biting profile shape corresponds to at least the portion of the stored shape related information."

In view of Chaum's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to use additional sensors such as reflection or infrared sensors and comparing the sensor's data as taught by Chaum along with the locking mechanism taught by Gokcebay et al. Gokcebay et al already teaches providing further security by incorporating a keypad for entry of an access code. One would be motivated to add extra sensors and use a comparator in order to provide additional security to the locking device.

9. Claims 8 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gokcebay et al (6,552,650) in view of Altschul et al (6,144,847).

Gokcebay et al's teachings are discussed above. Gokcebay et al however fails to teach the input being used to input a purchase amount in a commercial transaction environment.

Altschul et al teaches the following in regards to claims 8 and 42:



"Accordingly, once a purchase is made and the purchase amount is entered into the credit card account, as set forth above, the user may communicate telephonically with computer 110, as before, entering an input code to access the computer 110, entering the user's credit card account number and any further identifying code necessary, such as a personal identification number (PIN), the purchase amount and the transaction confirmation number, all with a keypad 230 serving as an input means." (Col. 6, lines 2-11).

In view of Altschul et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the input keypad as taught by Gokcebay et al for inputting purchasing prices as taught by Altschul et al. Gokcebay et al teaches using a keypad for additional security, so that an operator must enter a code in order to use the key. One would be motivated to combine the teachings of Gokcebay et al and Altschul et al in order to use Gokcebay et al's secure key for additional applications such as purchasing. This would extend the use of the Gokcebay et al's key and therefore be more marketable.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gokcebay et al (6,552,650) in view of Denison et al (6,359,547).

Gokcebay et al's teachings are discussed above. Gokcebay et al however fails to teach the input device being housed on a portion of the lock.

Denison et al teaches the following in regards to claim 14:

Figure 1 shows the input device being housed on a portion of the lock.

In view of Denison et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to instead of placing the input device on the key as taught by Gokcebay et al, place the keypad in the same housing of the lock itself. Although the function of the keypad will not change, one would be motivated place the keypad on the lock itself in order to provide for a less cumbersome key as well as reducing the risk of damaging the keypad due to carrying around a key as all times.

11. Claims 7, 13, 19, 20, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gokcebay et al (6,552,650) in combination with Chaum (6,318,137) and in further view of Altschul et al (6,144,847).

Gokcebay et al's teachings in combination with the teachings of Chaum are discussed above. The combination however fails to teach the transaction being selected from a group consisting of a credit card transaction and a consumer purchase transaction.

Altschul et al teachings are also discussed above (in regards to claims 7, 13, 19, 20, and 41), which include the transaction including a credit card transaction.

In view of Altschul et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the input keypad as taught by Gokcebay et al for credit card transactions as taught by Altschul et al. Gokcebay et al teaches using a keypad for additional security, so that an operator must enter a code in order to use the key. One would be motivated to combine the teachings of Gokcebay et al and Altschul et al in order to use Gokcebay et al's secure key for additional

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applications such as purchasing. This would extend the use of the Gokcebay et al's key and therefore be more marketable.

12. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gokcebay et al (6,552,650) in combination with Chaum (6,318,137) and in further view of Denison et al (6,359,547).

Gokcebay et al's teachings in combination with the teachings of Chaum are discussed above. The combination however fails to teach the input device being housed on a portion of the lock.

Denison et al teaches the following in regards to claim 24:

Figure 1 shows the input device being housed on a portion of the lock.

In view of Denison et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to instead of placing the input device on the key as taught by Gokcebay et al, place the keypad in the same housing of the lock itself. Although the function of the keypad will not change, one would be motivated place the keypad on the lock itself in order to provide for a less cumbersome key as well as reducing the risk of damaging the keypad due to carrying around a key as all times.

13. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gokcebay et al (6,552,650) in combination with Chaum (6,318,137) and in further view of Denison et al (6,359,547).

Gokcebay et al's teachings in combination with the teachings of Chaum are discussed above. The combination however fails to teach the input device being housed on a portion of the lock.

Denison et al teaches the following in regards to claim 32:

Figure 1 shows the input device being housed on a portion of the lock.

In view of Denison et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to instead of placing the input device on the key as taught by Gokcebay et al, place the keypad in the same housing of the lock itself. Although the function of the keypad will not change, one would be motivated place the keypad on the lock itself in order to provide for a less cumbersome key as well as reducing the risk of damaging the keypad due to carrying around a key as all times.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Moorhouse et al (6,764,007), Hart (4,090,175), Fort (3,889,501), Li (2002/0112512), Lambert (5,964,111), Henderson et al (2005/0168320), and Kayoda (6,526,786).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [[allyson.trail@uspto.gov](mailto:allyson.trail@uspto.gov)].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Allyson N. Trail  
Patent Examiner  
Art Unit 2876  
August 4, 2005

*Jared J. Fureman*  
**JARED J. FUREMAN**  
**PRIMARY EXAMINER**